



8/24/02
3/E/c

Docket No.: 8697.001.00-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Stephen J. DAVIS

Application No.: 09/446,951

Filed: February 28, 2000

For: STEP APPARATUS

RECEIVED

AUG 26 2002

Group Art Unit: 3627

GROUP 3600

Examiner: M. Cuff

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Dear Sir:

In response to the Election requirement mailed June 20, 2002, Applicant provisionally elects Species IV, covered by Figure 6. Applicant's Election is made with traverse and requests reconsideration. Applicant respectfully directs the Examiner M.P.E.P. § 823 and § 1893.03(d). Specifically, the Examiner is directed towards the following section:

Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and Chapter II) and in nation stage (filed under 35 U.S.C. § 371) applications. Restriction practice continues to apply to U.S. national applications filed under 35 U.S.C. 111(a). When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

Manual of Patent Examining Procedure (M.P.E.P.) § 1893.03(d) (8th ed. 2001) (emphasis added).

Applicant respectfully traverses the election requirement and requests reconsideration as the Examiner's burden has not been established. The Application was filed as a § 371 of PCT/AU98/00502 and is subject to PCT Rule 13 and 37 C.F.R. § 1.475, not the U.S. restriction practice. Accordingly, Applicant respectfully submits that the Examiner has not met his burden in restricting the claims of the present invention. As required and set forth in the MPEP paragraph reproduced above, the Examiner did not provide a list of the different groups of claims and did not explain why each group lacks unity with each other group. Rather the Examiner merely states, "The shown steps have only the feature of a step in common which is not considered to be a 'special technical feature' in defining a 'step apparatus'." (Office Action at 5.). However, this statement clearly implies there is a single inventive concept. (e.g., the step)

Additionally, Applicant directs the Examiner to the related International Application Published under the Patent Cooperation Treaty (PCT) (WO 99/01303), which provides *prima facie* evidence of unity of invention. For example only, one unique special technical feature in each Figure is a step arranged on a hitch assembly. Accordingly, Applicant submits unity of invention is clearly present linking all of the claims in the present application.

Finally, Applicant submits that continuing to examine the present application provides no additional burden as the Examiner has already provided a search and examined the pending claims. For at least the foregoing reasons, Applicant requests withdrawal of the restriction requirement.

Applicant traverses the Examiner's notes and comments and reconsideration is hereby requested. The Examiner has not provided a single formal rejection. Accordingly, Applicant awaits a formal rejection in order to properly reply.

The Examiner states, "In starting over, claim 38 is no long considered allowable." (Office Action at 3.) However, the Examiner provides no rejection to support the withdrawal of the allowable claim. Accordingly, Applicant submits that claim 38 is allowable over the prior art of record as no rejection is present.


If the Examiner deems that a telephone call would further the prosecution of this application, the Examiner is invited to call the undersigned at (202) 496-7500. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. § 1.136, and any additional fees required under 37 C.F.R. § 1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

An action on the merits of all the claims and a Notice of Allowance thereof are respectfully requested.

Dated: August 20, 2002

Respectfully submitted,

By 
Song K. Jung
Registration No.: 35,210

Rebecca Goldman Rudich
Registration No.: 41,786

MCKENNA LONG & ALDRIDGE LLP
1900 K Street, N.W.
Washington, DC 20006
(202) 496-7500
Attorneys for Applicant



30827

PATENT TRADEMARK OFFICE